



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,861	08/04/2000	Masayuki Chatani	375.05.01	2447

25920 7590 04/22/2003

MARTINE & PENILLA, LLP
710 LAKEWAY DRIVE
SUITE 170
SUNNYVALE, CA 94085

EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,861

Applicant(s)

CHATANI, MASAYUKI

Examiner

Kambiz Abdi

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
 - Claims 1, 2, and 8 are amended.
 - Claims 1-16 have been considered.
3. Examiner withdraws objection to the drawings and specification due to correction by the applicant.

Response to Amendment

Applicant's arguments filed 12 February 2003 have been fully considered but they are not persuasive for the following reasons:

- In response to applicant argument regarding rejection of Claim 1 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,619,247 to James Russo in view of U.S. Patent No. 5,530,754 to Norton Garfinkle and U.S. Patent No. 5,809,145 to David Slik.

Contrary to applicant's assertion, Russo clearly teaches the request for download, or scheduling the download of digital content into the user's system (See Russo column 7, lines 15-22, column 9, lines 45-51 and column 10, lines 5-10). As for the download of specific key for specific content at the user's system again Russo clearly teaches such scheme (See Russo column 6, lines 8-21). It is self-evidence that there has to be an identification of end user by the central system to be able to overcome the creation of specific key for the subscriber system. In addition Garfinkle clearly teaches transmission of data that identifies the end user as well as identifying data that identifies the content to be downloaded to the end user's system to the central station (See Garfinkle column 4, lines 2-6 and lines 59-65). As for utilization of alphanumeric media ID, it is industry wide practice that storage medias have an alphanumeric identification. This helps the tracking of each storage media and the identification of final user. As the examiner has pointed out in previous office action "data structure" and "detachable storage

Art Unit: 3621

media" are non-functional descriptive language that is indicative of intended use of data stored within the data storage media. They do not constitute an inventive step within the art. However, both Garfinkle and Slik clearly teach the detachable storage media and the inherency of using media ID and Storage IDs for identification of the end users. (See Garfinkle figures 1, 2 and associated text, and Slik figure 1, 2, 11, and 13, and 16 and its associated text, column 6, lines 9-68, column 7, lines 1-68, and column 8, lines 1-38)

Claim Objections

4. Objection to claim 8 has been withdrawn based on the amended correction that has been made to the claim by the applicant.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Examiner's Note: Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in

Art Unit: 3621

preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

5. Claims 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,619,247 to James Russo.

6. As for claim 13, Russo discloses a method of operating a client console having a detachable storage media installable therein while connecting with a download management server through a bi-directional communications network, comprising the steps of:

- downloading primary content data from a content server to a client computer upon request by a user (See Russo Figures 1 and 2 and associated text, column 7, lines 3-22, column 9, lines 65-68, and column 10, lines 1-10,);
- scheduling downloading of the contents from a contents database of content server (See Russo column 9, lines 38-51);
- writing the downloaded contents into a re-writeable storage media coupled to the client computer (See Russo column 4, lines 45-63, column 5, lines 1-10)
- recording a usage history of the downloaded primary content data when the downloaded contents is used or otherwise accessed by the user (See Russo column 34-65, column 6, lines 34-53, and column 10, lines 10-48); and
- charging a fee based on the usage of the contents (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

7. As for claim 14, Russo discloses the method according to claim 13, further;
Russo discloses the step of communicating usage of the primary contents to a customer database maintained by the content provider (See Russo column 10, lines 23-49).

8. As for claims 15 and 16, Russo discloses the limitations of claim 14, further;
Russo discloses, the downloaded primary content comprises time sensitive content data, and further comprising the step of deleting expired contents that are not used by the user upon the occurrence of a

Art Unit: 3621

lapse of a specified period of time (See Russo figure 2 and associated text, column 5, lines 1-10, and column 5, lines 33-47).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,619,247 to James Russo in view of U.S. Patent No. 5,530,754 to Norton Garfinkle and U.S. Patent No. 5,809,145 to David Slik.

11. As per claims 1 and 9, Both Russo and Garfinkle discloses a system for providing access to primary media content in digital form, comprising:

- a server network comprising (See Russo figures 1, 2 and associated text, column 3, lines 1-28, and column 4, lines 22-68, and Garfinkle figures 1, 2, 3, and 5 and associated text, column 2, lines 39-68, and column 3, lines 1-19);
- a download management server (See Russo figures 1, 2 and associated text, column 1, lines 39-68, column 3, lines 1-28, column 4, lines 22-68, and column 9, lines 65-68, and column 10, lines 1-10, and Garfinkle figures 1, 2, 3, and 5 and associated text, and column 2, lines 39-68, and column 3, lines 1-19);
- a customer database storing user information (See Russo column 5, lines 33-65, and column 10, lines 25-38, and Gorfinkle figures 1, 2, 3, and 5 and associated text, and column 4, lines 2-7, lines 35-46, and lines 59-65, and column 5, lines 3-18). Additionally, it would be inherent in any of this type of systems (Transactional) to collect and store data and identifiers related to the end users and related data the user is trying to obtain. It is inherent to have a database of information

Art Unit: 3621

regarding the end users information (Profiles, financial, and ordering habits) this helps to keep track of transactions and the keeping record of the interaction between users and central controller.

- a primary content database storing primary media content (See Russo figures 1, 2 and associated text, column 3, lines 1-28, column 4, lines 22-68, and column 5, lines 1-65, and Gorfinkle figures 1, 2, 3, and 5 and associated text, and column 4, lines 35-46);
- a client console connectable for establishing a communications link through a bi-directional communications network to said download management server (See Russo figures 1, 2 and associated text, column 3, lines 1-28, column 4, lines 22-68, and column 5, lines 1-65, and Gorfinkle figures 1, 2, 3, and 5 and associated text, and column 4, lines 2-6);
- the server network is configured to transmit to the client console a plurality of media content items upon request by a user of the client console (See Russo Figures 1 and 2 and associated text, column 7, lines 3-22, column 9, lines 65-68, and column 10, lines 1-10, and Gorfinkle figures 1, 2, 3, and 5 and associated text, and column 5, lines 3-14), and
- a content provider providing data through the primary content database charges the user only for items used by the user (See Russo column 10, lines 1-22).
- a user identifier is uploaded to said download management server to enable access to specified content in said primary media content database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38), and
- said user information is downloaded into said client console to trigger execution of specified revenue bearing events (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),

But, Russo is not specific on (See Russo column 9, lines 38-51);

- a detachable storage media installable in said client console (See Gorfinkle figures 1, 2, 3, and 5 and associated text, and column 1, lines 48-57);

However, Garfinkle clearly teaches the option and usefulness of using a detachable storage media (CD-ROM) for catalog distribution. Accordingly, it would have been obvious to one having ordinary skill in the

Art Unit: 3621

art at the time the current invention was made to incorporate the teachings of Garfinkle into of Russo's to achieve a more efficient distribution of catalog content.

But, Russo is not specific on;

- said detachable storage media having a data structure thereon comprising at least one of a user identifier and a media identifier (Examiner's notes: "data structure" and "detachable storage media" are non-functional descriptive language that is indicative of intended use of data stored within the data storage media.) (See Garfinkle figures 1, 2 and associated text, and Slik figure 1, 2, 11, and 13, and 16 and its associated text, column 6, lines 9-68, column 7, lines 1-68, and column 8, lines 1-38)

However, both Garfinkle and Slik clearly teach the detachable storage media and the inherency of using media ID and Storage IDs for identification of the end users. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Garfinkle and Slik into Russo's to have a more secure and controllable data distribution system.

- recording usage of primary media content by the user (See Russo figure 2 and associated text, and column 5, lines 1-9, column 5, lines 33-65, and column 10, lines 10-48);
- charging the user for the primary media based on portions of the primary media actually used (See Russo figure 2 and associated text, and column 5, lines 1-9, column 5, lines 33-65, column 9, lines 38-65, and column 10, lines 10-48).

12. As for claim 2, Russo, Garfinkle, and Slik disclose the limitations of claim 1, further;

Russo discloses,

said user identifier comprises an alphanumeric media ID identifying said detachable storage media (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

13. As for claim 3, Russo, Garfinkle, and Slik disclose the limitations of claim 2, further;

Russo discloses,

said specified content comprises a portion of an overall set of primary contents stored in said contents database, and

Art Unit: 3621

said media ID serves to limit access to said specified content only (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

14. As for claim 4, Russo, Garfinkle, and Slik disclose the limitations of claim 1, further;

Russo discloses,

said data structure comprises an authentication code for authenticating access to the download management server (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

15. As for claim 5, Russo, Garfinkle, and Slik disclose the limitations of claim 4, further;

Russo discloses,

said specified content comprises a portion of an overall set of primary contents stored in said contents database, and

said authentication code authenticates access to the download management server which is responsible for providing access to said specified content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

16. As for claim 6, Russo, Garfinkle, and Slik disclose the limitations of claim 1, further;

Russo discloses,

the media items comprise a plurality of trigger data items logically associated, respectively, with each of said primary media content items, and

the trigger data items are used to compile and store a usage history of the primary content items in the customer database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

17. As for claim 7, Russo, Garfinkle, and Slik disclose the limitations of claim 6, further;

What Russo is not explicit on is,

data structure further comprises a data indicator indicating that said detachable storage media is operable through connection to said bi-directional communications network, and

further said data indicator comprises one of a program for providing network access and a code which causes execution of a program stored in said media console for providing network access (See

Art Unit: 3621

Gorfinkle figures 1, 2, 3, and 5 and associated text, column 2, lines 1-12, column 1, lines 48-57, column 3, lines 19-31, column 4 lines 1-6, and column 4, lines 59-65).

However, Garfinkle clearly teaches the option and usefulness of using a detachable storage media (CD-ROM), an interactive video display, and a bi-directional communication network to achieve selection, download and presentation of a primary content downloaded to the end user system. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Garfinkle into of Russo's to achieve a more efficient distribution and control over the primary content downloaded to end users system.

18. As for claim 8, Russo, Garfinkle, and Slik disclose the limitations of claim 1, further;

Russo discloses,

said client console further comprises a local fixed storage device disposed internally or externally of said client console,

said requested primary media content is downloaded only said fixed storage device (See Russo figure 2 and associated text, column 4, lines 45-65, column 5, lines 33-65, column 6, lines 12-53, column 8, lines 11-19, and column 10, lines 54-59).

19. As for claim 10, Russo, Garfinkle, and Slik disclose the limitations of claim 9, further;

Russo discloses,

said user identifier data comprises an alphanumeric media ID identifying said detachable storage media and said local storage media further contains an authentication code which enables access to said download management server,

further comprising the step of receiving said media ID and said authentication code in said download management server,

one of said authentication code and said media ID serves to limit access to specified content only from among said primary media content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38)..

20. As for claim 11, Russo, Garfinkle, and Slik disclose the limitations of claim 9, further;

Russo discloses,

Art Unit: 3621

the media content comprises one or more data content items associated with a respective payment trigger item,

said payment trigger item operable to compile and store usage information of the media content in a customer database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

21. As for claim 12, Russo, Garfinkle, and Slik disclose the limitations of claim 9, further;

Russo discloses,

said step of downloading into said client console from said download management server comprises storing said primary media content on a local fixed storage device disposed internally or externally of said client console (See Russo figure 2 and associated text, column 4, lines 45-65, column 5, lines 33-65, column 6, lines 12-53, column 8, lines 11-19, and column 10, lines 54-59).

Conclusion

22. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

Art Unit: 3621

advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to:

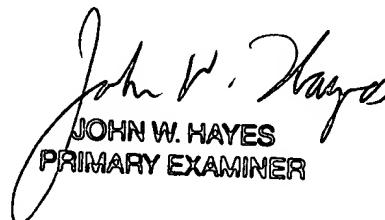
(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Abdi/K
April 21, 2003


**JOHN W. HAYES
PRIMARY EXAMINER**